

REMARKS/ARGUMENTS

Claim 8-22 are currently pending. Claims 1-7 are withdrawn pursuant to a previous restriction requirement.

Claims 8-11, 13-20 are rejected under 35 U.S.C. 103(a) as being obvious over Marui (U.S. 4,231,829) in view of Suzumura (U.S. 3,316,190). Claim 12 is rejected under 35 U.S.C. 103(a) as being obvious over Marui and Suzumura in view of Smyser (U.S. 3,220,992). Applicants traverse these rejections.

While Applicants maintain that there is no *prima facie* case of obvious because the claimed surface tension is not inherent in the theoretical combination of Marui and Suzumura, Applicants wish to first re-emphasize that the Office is required to consider arguments to rebut *prima facie* obviousness. Specifically, MPEP 2145 states “If a *prima facie* case of obviousness is established, **the burden shifts to the applicant to come forward with arguments and/or evidence to rebut the *prima facie* case. Rebuttal evidence and arguments can be presented in the specification, . . . Office personnel should consider all rebuttal arguments and evidence presented by applicants.**” Applicants note that the Office has failed, in the Office Action issued June 22, 2010, to consider the rebuttal arguments and evidence presented by Applicants in the Response filed March 18, 2010.

Specifically, although Applicants maintain that a case of *prima facie* obviousness has not been made, the results demonstrated in Examples 3-5 are sufficient to rebut the same. “[E]vidence of unobvious or unexpected advantageous properties, such as superiority in a property the claimed compound shares with the prior art, can rebut *prima facie* obviousness. “Evidence that a compound is unexpectedly superior in one of a spectrum of common properties . . . can be enough to rebut a *prima facie* case of obviousness.” No set number of

examples of superiority is required. *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987).”

The hydraulic transfer printing base film comprising a nonionic surfactant according to the present invention allows for the transfer of high-definition print patterns to the surface of an article having irregularities or a curved surface (*See* pg. 7, lines 16 to 23; pg. 9, lines 18-22). Specifically, it has been found that by adjusting the surface tension of the aqueous solution, comprising 0.01% by weight of a nonionic surfactant, to a certain value or lower (40mN/m) at 20°C, it is possible to inhibit a resulting transfer sheet from extending due to its swelling on the surface of the aqueous solution (*See* Examples 3, 4 and 5; pg. 50-56). In Examples 3 to 5, the nonionic surfactants provide an aqueous solution which at 20°C, comprising 0.01% by weight of said surfactant, has a surface tension of 40mN/m or less (27.8 and 31.1mN/m). The extension ratios for Examples 3-5, calculated after 5 times the period of time needed for the surface of the film to become smooth once the hydraulic transfer printing base film is floated on the surface of the aqueous solution, are 1.47, 1.38, and 1.50, respectively (*See Specification*; pg. 48, line 24 to pg. 49, line 2).

In contrast, when the surface tension of an aqueous solution exceeds 40 mN/m, it becomes increasingly difficult to suppress the extension of a transfer sheet on the surface of the aqueous solution, resulting in blur of the print pattern and making it extremely difficult to transfer a clear, high definition pattern (*See* Comparative Example 5, pg. 57).

Thus, Examples 3-5 clearly illustrate that the hydraulic transfer printing base film according to the present invention make it possible to inhibit extension of a resulting transfer sheet when floating the transfer sheet on the surface of water to swell it. Specifically, as declared in the 37 C.F.R. § 1.132 Declaration Submitted herewith, Marui does not disclose the specific nonionic surfactant nor the surface tension of the nonionic surfactant, and thus a person skilled in the art cannot understand the relationship between the extension of the

resulting transfer sheet and the kind of the nonionic surfactant from Marui. In addition, Suzumura only discloses a cold water-soluble PVA film that is non-sticky at high humidity and Suzumura does not disclose at all the hydraulic transfer printing base film nor resulting transfer sheet. Accordingly, a person skilled in the art would not expect the result concerning the extension of the resulting transfer sheet from Suzumura, and the results demonstrated in Examples 3-5 are unexpected in view of Marui and Suzumura (See 37 C.F.R. § 1.132 Declaration Submitted herewith).

Applicants submit that, even if a *prima facie* case of obviousness can be established, these results demonstrated in Examples 3-5 are clearly sufficient to rebut the same.

Furthermore, Applicants maintain their previous arguments that neither Marui or Suzumura disclose the specific nonionic surfactant claimed wherein an aqueous solution at 20°C, comprising 0.01% by weight of the nonionic surfactant, has a surface tension of 40mN/m or less. The Examiner argues that it would have been obvious to replace the unspecified non-ionic surfactant of Marui with the ethylene oxide adducts of lauryl alcohol of Suzumura. However, the Examiner appears to take the view that simply because Suzumura discloses polyoxyethylene type nonionic surface active agents, Suzumura “inherently” discloses an aqueous solution with a surface tension of 40 mN/m or less. However, the examiner has no proof of this. Applicants note that according to MPEP 2112 (IV), the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). As noted by the court in *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323 (CCPA 1981), the mere fact that a certain thing may result from a given set of circumstances is not sufficient to prove inherency. Inherency may not be established by probabilities or possibilities. Something that is inherent must inevitably be the result each and every time.

It is by now well settled that the burden of establishing a *prima facie* case of inherency resides with the Patent and Trademark Office. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984), quoting *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967). Before an Examiner can switch the burden of proof of showing non-inherency to the applicant, the Examiner must provide some evidence or scientific reasoning to establish the reasonableness of the Examiner's belief that the limitation is an inherent characteristic of the prior art. In this case, the Examiner has provided no such evidence other than simply concluding that Suzumura discloses nonionic surface active agents including ethylene oxide adducts of lauryl alcohol (Official Action; pg. 3, lines 14-17)

In view of the foregoing, Applicants request withdrawal of the 35 U.S.C. 103(a) rejection over Marui in view of Suzumura.

Claim 12 is rejected under 35 U.S.C. 103(a) as being obvious over Marui and Suzumura in view of Smyser (U.S. 3,220,992). However, Smyser fails to cure the deficiencies of Marui and Suzumura. Specifically, Smyser fails to disclose or suggest the specific nonionic surfactant claimed wherein an aqueous solution at 20°C, comprising 0.01% by weight of the nonionic surfactant has a surface tension of 40mN/m or less. Accordingly, Applicants request withdraw of this rejection.

**Conclusion**

For the reasons discussed above, Applicants submit that all now-pending claims are in condition for allowance. Applicants respectfully request the withdrawal of the rejections and passage of this case to issue. Should the Examiner have any questions regarding the claims or otherwise wish to discuss this case, he is kindly invited to contact Applicants' below-signed representative, who would be happy to provide any assistance deemed necessary in speeding this application to allowance.

Respectfully submitted,

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